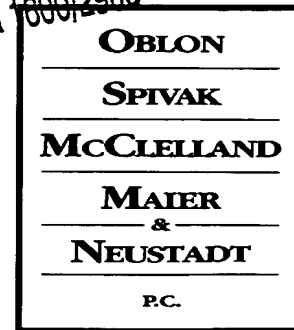




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Docket No.: 199553USO

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

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RE: Application Serial No.: 09/728,121  
Applicants: Eiichi MASUHARA, et al.  
Filing Date: December 4, 2000  
For: DENTAL AND ORALOGIC COMPOSITION  
Group Art Unit: 1614  
Examiner: D.A JAGOE

SIR:

Attached hereto for filing are the following papers:

**RESPONSE TO RESTRICTION REQUIREMENT (3 pp.)**

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
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Registration No. 50,552

Docket No.: 199553US0



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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

:

Eiichi MASUHARA, et al.

: EXAMINER: JAGOE

SERIAL NO: 09/728,121

:

FILED: DECEMBER 4, 2000

: GROUP ART UNIT: 1614

FOR: DENTAL AND ORALOGIC COMPOSITION

RESPONSE TO RESTRICTION REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

In response to the Office Action mailed March 12, 2002, Applicants elect, with traverse, Group I, Claims 1-12 and 21-23, for further prosecution.

REMARKS

The Office has restricted this application as follows under 35 U.S.C. §121:

Group I: Claims 1-12 and 21-23, drawn to compositions comprising photocatalytic titanium oxide;

Group II: Claims 13, 20, and 24, drawn to a method for producing a film or dental and orologic composition; and

Group III: Claims 14-19, drawn to a method of using the photocatalytic titanium oxide in dental procedures.

Applicants have elected Group I, Claims 1-12 and 21-23, with traverse.

Applicants note that claims of Groups II and III are directly dependent from the claims of Group I, as such these groups are not separable.

The Office has characterized the inventions of Group I and Group II as related as process of making and product made. Citing MPEP §806.05(f) the Office suggests that the process as claimed can be used to make another and a materially different product, such as “coating glass or ceramics”. However, there is no evidence of record to show that the claimed process could be used as the Office has alleged. If, in fact, the claimed process can be used to make "coating glass or ceramics," the Office has failed to show that the alleged product is materially different from the claimed product. Accordingly, Applicants respectfully submit that the Restriction Requirement is unsustainable, and it should therefore be withdrawn.

In regard to Groups I and III, the Office has characterized the relationship between these two groups as product and process of use. Citing MPEP §806.05(h), the Office concludes that “curing halitosis can be accomplished using ordinary mouthwashes or regular oral hygiene such as tooth brushing.” However, the Office has failed to show that the proposed process is materially different from the claimed process. Accordingly, Applicants respectfully submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

Moreover, MPEP §803 states as follows:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct or independent inventions.

Applicants submit that a search of all claims would not constitute a serious burden on the Office.

For the reasons set forth above, Applicants contend that the Restriction Requirement is improper and should be withdrawn.

Finally, MPEP §821.04 states:

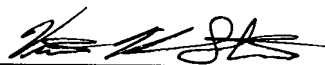
...if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Applicants respectfully submit that should the elected group be found allowable, non-elected claims should be rejoined.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



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